

Title: *Absolutely* Not Registrable

Social media text: Trade Mark Attorney Sarah Neil takes a look at some recent noteworthy trade mark applications refused by the UK IPO on absolute grounds.

Main article body:

As a Trade Mark Attorney, one of the questions we are asked on an almost daily basis is whether new marks are registrable. As UK IPO practice is forever evolving, it can be helpful to conduct regular reviews of the kinds of marks being refused by the UK IPO. We take a look at some interesting refusals which have issued recently.

Bad faith – not just an issue for contentious proceedings

Bad faith has been a hot topic in contentious trade mark matters over the last few years, and two recent refusals remind us that in the UK bad faith can also be raised by the UK IPO as a ground to refuse a trade mark application. Global Trademark Services Limited filed applications for the following marks covering goods in class 25:



(No. 3587268) and



(No. 3595047)

The first mark clearly displays the name HENRY and the second application includes the name RONALDINHO. Both applications were refused under section 3(6) of the Trade Marks Act on the grounds that the applications, which consist of the names of famous footballers imprinted upon logos which are confusingly similar to that of well-known football clubs, were filed in bad faith. The UK IPO raised of its own motion the ‘well known facts’ that Henry and Ronaldinho are the names of famous football players and that the marks applied include badges which are very similar to those of Arsenal and Barcelona football clubs, which are clubs for which the respective players famously played. In relation to the Ronaldinho mark, it was also noted that the silhouette included in the mark incorporated Ronaldinho’s *“characteristic long flowing hair at the back”*. The Hearing Officer had no doubt that the relevant consumer would recognise the respective marks as referring to the famous football players Henry and Ronaldinho. Without evidence of consent from the players themselves, the Hearing Officer found that the absence of any proper and plausible explanation from the Applicant as to why the applications were filed, amounted to bad faith. The Applicant tried to overcome the refusal at a hearing by pointing to hundreds of similar registrations he owns which include the name of famous footballers, some more famous than others. The Applicant tried to argue that the previous acceptance of such trade marks gave him an expectation that these marks would also be accepted. Unfortunately for him, the Hearing Officer considered this to support a finding of bad faith as it demonstrated a pattern of behaviour which could *“seriously impact the registration of trade marks and those relating to famous people in particular”* and which could *“be a*

serious risk of the mechanism of trade mark registration being brought into disrepute". Appeals before the Appointed Person are pending and decisions are expected soon.

Filing in a foreign script won't save a descriptive mark

Dehua County Ceramic Trade Association tried to avoid a refusal of its application for the mark



by including words in both English and Chinese. Unfortunately for the Applicant, the UK IPO identified that the Chinese characters were a direct transliteration of the English words DEHUA PORCELAIN. Dehua porcelain is a white Chinese porcelain and the phrase is therefore descriptive of the pottery goods applied for. The UK IPO considered that Chinese is largely understood in the UK and that the goods applied for could be aimed at Chinese consumers in the UK. The application was therefore refused under section 3(1)(b) and(c) of the Trade Marks Act for lacking distinctive character and being descriptive. Attempting to monopolise a descriptive phrase is always going to be problematic, but perhaps the Applicant should have considered whether alternative forms of protection were more appropriate on this occasion, such as a certification mark or an attempt to register DEHUA as a Geographical Indication.

Shapes marks can lack distinctive character

When it comes to 3D shape marks, the most anticipated objection is usually under section 3(2) which prohibits registration of marks which consist exclusively of a shape which results from the nature of the goods themselves. The UK IPO avoided this objection when assessing the registrability



of the mark , opting instead to refuse the application under section 3(1)(b) on the basis that the mark had no distinctive character as it merely consisted of a representation of the goods. The goods covered included a range of acupressure mats, massagers and acupuncture equipment as well as pillows, cushions and seat covers. If this shape does represent a pillow or a cushion, I'm not sure it's one I would want to lie my head on!

The obligatory covid application

Throughout 2021, the UK IPO still continued to see new applications for covid related trade marks. When it came to examination of the mark STAY POSITIVE. TEST NEGATIVE, a refusal was issued that the sign is devoid of distinctive character. This refusal acts as a good reminder that the UK IPO does not consider slogans or promotional statements to be capable of acting as a trade mark and will issue a refusal under section 3(1)(b) absent any evidence of acquired distinctiveness.